

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

****BA-0342**

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Application Number

10/611,737

Filed

July 1, 2003

First Named Inventor

David R. Robins

Art Unit

2625

Examiner

Allen H. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

/Jon M. Isaacson/

Signature

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Jon M. Isaacson

Typed or printed name

☒

attorney or agent of record.

Registration number **60,436**

215-568-3100

Telephone number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

March 29, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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*Total of **1** forms are submitted.

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9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

DOCKET NO.: **BA-0342
Application No.: 10/611,737
Office Action Dated: December 28, 2009

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David R. Robins

Confirmation No.: **2570**

Application No.: **10/611,737**

Group Art Unit: **2625**

Filing Date: **July 1, 2003**

Examiner: **Allen H. Nguyen**

For: **HIGH-SPEED DIGITAL IMAGE PRINTING SYSTEM**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets. No more than five pages are provided.

REMARKS

Summary of application history

Claims 29-31, 36-37, and 42-56 are pending in the present application. All pending claims were rejected in the office action of December 28, 2009 ("Office Action"), as follows:

- Claims 29-30, 36-37, 43-45, 47-51, and 54-56 were rejected under 35 USC § 102(b) as being anticipated by Barry et al, US Patent 5,859,711 ("Barry").
- Claims 42, 46, and 53 were rejected under 35 USC § 103(a) as being unpatentable over Barry in view of Kito, US Patent 6,628,899 ("Kito").
- Claims 31 and 52 were rejected under 35 USC § 103(a) as being unpatentable over Barry in view of Nagasaka, US Patent 5,333,246 ("Nagasaka").

Applicants filed a response to the Office Action on March 1, 2010 ("Response"). In the Response, applicants suggested minor amendments to claims 50-52 and 55. (*See* Response, page 7.) Furthermore, in the Response, applicants argued that Barry fails to anticipate independent claims 29, 36, and 50. (*Id.*, at pages 8-10.) Notably, applicants' arguments are not related to the minor amendments to claim 50 for support of the assertion that Barry fails to anticipate the independent claims.

Following the filing of the Response, an advisory action was issued on March 17, 2010 ("Advisory Action"), in which applicants' proposed amendments were not entered and the Advisory Action argued that the Response did not place the application in condition for allowance because "[i]t relies on newly added claim/limitations, not being entered, and finally rejected claims limitations are still my by the prior art of record." (Advisory Action, pages 1-2.) No other reasons were given as to why the application is not in condition for allowance if the Response is entered.

In contrast to the assertions in the Advisory Action, applicants' arguments as to Barry's failure to anticipate the independent claims do not rely upon any claim amendments. Because of the Advisory Action's failure to reply to applicant's arguments and because of the page limit imposed on this request, applicants' present pre-appeal brief request for review focuses on Barry's failure to anticipate the independent claims. Any failure to raise any other error in this request should not be deemed a concession that there are no other such errors in this case.

Brief overview of applicants' independent claims

Claim 29 is generally directed to a "method for printing a plurality of digital images." Claim 29 recites that the method comprises "determining a subset of the plurality of digital images which *require image processing to meet a defined image parameter*" and "*performing image processing* on the digital images in the subset to produce a first plurality of processed images." (Emphases added.) Claim 29 also recites "printing the first plurality of processed images." Claims 36 and 50 are directed to a system and a computer-readable medium, respectively, which recite subject matter similar to those recitations of claim 29 mentioned above.

Regarding claim 50, the proposed amendments filed in the Response were not entered for purposes of appeal, as noted in the Advisory Action. Accordingly, applicants submit that the present request should be considered in light of claim 50 as it was pending as of the mailing of the Office Action (i.e., without considering the proposed amendments).

Rejections of applicants' independent claims under 35 USC § 102(b)

The Office Action relies heavily on the elements shown in Barry's Figure 12. The Office Action argues that Barry's Software RIP 350 determines a subset (Job 2 358) of a plurality of images (Job 352) to be printed. (Office Action, page 2.) Further, the Office Action argues that Virtual Job Router 354 performs image processing on Job 352 by routing the individual pages to Job 1 356 and Job 2 358. (*Id.* at pages 2-3.) Finally, the Office Action argues that Barry teaches that the pages in Job 2 require image processing to meet an image parameter because Barry teaches that "multiple pages of images are separate and distinct and have associated therewith parameters that define the nature of the document as to printing, col. 14, lines 55-60." (Office Action, page 2.) The Office Action applies this reasoning in the rejection of each of claims 29, 36, and 50 under 35 USC § 102(b). (Office Action, pages 2 and 4-6.)

Patentability of applicants' independent claim over Barry

Claim 29 stands rejected under 35 USC § 102(b) as being anticipated by Barry. For a reference to anticipate a claim, the reference must disclose each and every element of the claim expressly or inherently: "[a] claim is anticipated only if *each and every element* as set

forth in the claim is found, either expressly or inherently described, in a single prior art reference.” (MPEP § 2131 (citing *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814, F.2d 628, 631 (Fed. Cir. 1987) (emphasis added)); see also *In re Crish* 393 F.3d 1253, 1256 (Fed. Cir. 2004) and *Celeritas Techs. Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998).) Barry fails to teach each and every recitation of claim 29 for at least the following reasons.

First, the Office Action errs in finding that Barry teaches “determining a subset of the plurality of digital images which require image processing to meet a defined image parameter,” as recited by claim 29. In the portion of Barry cited by the Office Action, Barry describes that pages in Job 352 can be either color images or black and white images. (Barry, Fig. 12.) Barry further describes that the virtual job router 354 parses the pages of Job 352 into a group of black and white pages (Job 1 356) and a group of color pages (Job 2 358). (Barry, col. 14, lines 56-61.) Essentially, Barry describes determining whether the pages of Job 352 are color images or black and white images. Thus, Barry describes determining what the pages are, not what processing needs to be performed on the pages to meet some image parameter. Therefore, Barry’s determination of whether the pages of Job 352 are color or black and white does not teach “determining a subset of the plurality of digital images which require image processing to meet a defined image parameter,” as recited by claim 29.

Second, the Office Action errs in finding that Barry teaches “performing image processing on the digital images in the subset” where “[the] subset of the plurality of digital images...require[s] image processing to meet a defined image parameter,” as recited by claim 29. As discussed above, Barry describes that the virtual job router 354 parses the pages of Job 352 into a group of black and white pages (Job 1 356) and a group of color pages (Job 2 358). (Barry, col. 14, lines 56-61.) In effect, the parsing of the pages, as taught by Barry, is a separation of the pages based on what the pages are. Barry does not teach that the virtual job router 354 processes images in the pages to meet some image parameter. Therefore, Barry’s determination of whether the pages of Job 352 are color or black and white does not teach “performing image processing on the digital images in the subset” where “[the] subset of the plurality of digital images...require[s] image processing to meet a defined image parameter,” as recited by claim 29.

For at least these reasons, the Office Action errs in finding that Barry teaches each and every recitation of claim 29. Accordingly, applicants respectfully request withdrawal of the Office Action's rejection of claim 29 under 35 USC § 102(b) as being anticipated by Barry.

Claims 36 and 50 respectively recite a system and a computer-readable medium and the computer-readable storage medium. As pending when the Office Action was mailed, claims 36 and 50 contain similar recitations to those of claim 29 discussed above. For at least the reasons discussed above regarding claim 29, applicants respectfully submit that the Office Action errs in finding that Barry teaches each and every recitation of claims 36 and 50. Accordingly, applicants respectfully request withdrawal of the Office Action's rejection of claims 36 and 50 under 35 USC § 102(b) as being anticipated by Barry.

Claims 30-31, 37, 42-49, and 51-56 depend, directly or indirectly, from claims 29, 36, and 50. The rejections of claims 30-31, 37, 42-49, and 51-56 under 35 USC §§ 102(b) and 103(a) rely on Barry to anticipate claims 29, 36, and 50. Inasmuch as Barry fails to anticipate claims 29, 36, and 50, applicants request withdrawal of the rejection of claims 30-31, 37, 42-49, and 51-56 under 35 USC §§ 102(b) and 103(a).

Conclusion

For the foregoing reasons, applicants respectfully request withdrawal of the rejections of claims 29-31, 36-37, and 42-56 under 35 USC §§ 102(b) and 103(a) and solicit their allowance.

Date: March 29, 2010

/Jon M. Isaacson/

Jon M. Isaacson

Registration No. 60,436

Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439